



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,173	12/31/2003	Edward B. Zalenski	3518.1020-000	5023
21005	7590	03/07/2007	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133			REIMERS, ANNETTE R	
		ART UNIT	PAPER NUMBER	
		3733		
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	03/07/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

ED

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/750,173	ZALENSKI ET AL.	
	Examiner Annette R. Reimers	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 01 December 2006.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) 8, 10, 14 and 16-30 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-7, 9, 11-13 and 15 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 30 August 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date. _____	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 9, 11, 12 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Markworth et al. (US Patent Publication Number 2003/0199872), cited by applicant.

Markworth et al. disclose various embodiments of an implant implantation device comprising a frame having a trigger mechanism, 514, an outer sleeve, 400, mechanically coupled to the frame, an inner shaft, 300, having a grabber, 206, for mechanically engaging an implant, wherein the inner shaft is slidably disposed along a major axis of the inner shaft within the outer sleeve, whereby actuation of the trigger extends the grabber from the outer sleeve to thereby release the implant, and a retaining spring element, 600, for directing the grabber toward a closed position, whereby the grabber is substantially contained within the outer sleeve when the trigger is released (see figures 6A, 6B, 7A and 7B). The device further includes a drag adjustment screw, 108, rotatably coupled to the frame for providing tension between the

trigger mechanism and the inner shaft, and a including a depth control member, 200, slidably coupled to the outer sleeve, wherein the depth control member provides a predetermined insertion depth of the implant (see figures 6A, 6B, 7A and 7B). The device also includes a protrusion, 112, on the outer sleeve for slidably engaging a distraction instrument (see figures 6A, 6B, 7A and 7B). Markworth et al. further disclose a knob, 712, mechanically coupled to the outer sleeve, wherein the knob is capable of causing the outer sleeve and the inner shaft to be rotated about the frame (see figures 7A and 7B and paragraphs 0057-0060). The grabber includes grabber tips for mechanically engaging an implant wherein the grabber tips include a first pair of slots for engaging a first engagement tab of the implant and a second pair of slots for engaging a second engagement tab of the implant and wherein a sizing slot is located between the first pair of slots and the second pair of slots to allow for a variation of tab and slot dimensional differences (see figure1C). The grabber further includes markings, e.g. 111, to identify a position of an implant, and the grabber is capable of being removably coupled to the inner shaft (see figures 6A, 6B, 7A and 7B).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Markworth et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ

781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Markworth et al. (US Patent Publication Number 2003/0199872) in view of Lim (US Patent Publication Number 2005/0055031).

Markworth et al. disclose the claimed invention except the marking being a pin. Lim discloses an implant implantation device and teaches the use of an indicator pin to indicate the positioning of the clamping members relative to one another (see paragraph 0064). Since the grabber of Markworth et al. is elastic such that application of a force causes the fingers to separate (see paragraph 0042), it would have been obvious to one skilled in the art at the time the invention was made to construct the device of Markworth et al. with the grabber including an indicator pin, in view of Lim, in order to indicate the positioning of the clamping members relative to one another.

***Response to Arguments***

Applicant's arguments filed December 1, 2006 have been fully considered, but they are not persuasive. Examiner respectfully disagrees with applicant regarding Markworth et al. The retaining spring element, 600, of Markworth et al. does direct a grabber, 206, toward a closed position via slide, 300, and sleeve, 400, whereby the grabber is substantially contained within the outer sleeve when the trigger is released. (see paragraph 0051, particularly lines 10-23). Movement of the retaining spring element, 600, results in the advancement of the slide, 300, and sleeve, 400, which in turn directs the grabber, 206, toward a closed position (see paragraphs 0054 and 0055, particularly lines 6-9 of paragraph 0054 and lines 4-6 of paragraph 0055). Furthermore, the actuation of trigger, 514, does release the coupling element (see paragraph 0051, particularly lines 31-36). Thus, Markworth et al. disclose an inner shaft, 300, having a grabber, 206, for mechanically engaging an implant, wherein the inner shaft is slidably disposed along a major axis of the inner shaft within the outer sleeve, 400, whereby actuation of the trigger, 514, extends the grabber from the outer sleeve to thereby release the implant.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR





EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER